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EXAMINER

HARRIS, ERICA B

ART UNIT PAPER NUMBER

3634

DATE MAILED: 01/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/051,948

Applicant(s)

ROSENBERG ET AL.

Examiner

Erica B Harris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

*Information to Pro Se Inventors  
Regarding responses to Office Actions*

INTRODUCTION

An examination of this application reveals that applicant may be unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed.

Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application. The value of a patent is largely dependent upon skillful preparation and prosecution. Although the services of a registered patent attorney or agent is advised, the Office cannot aid in selecting an attorney or agent.

37 C.F.R. § 1.31; M.P.E.P. § 401. However, Applicant is encouraged to peruse the publication entitled "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

DISCUSSION

The following discussion provides general information for Applicant's benefit regarding an applicant's response, new matter, the period for response, and the certificate of mailing.

**I. Response by Applicant**

The applicant **MUST** respond to every ground of rejection and objection made in an Office action. 37 C.F.R. § 1.111. The applicant will generally present arguments that the examiner's rejections or objections were made in error; or amend the specification, drawings, and/or claims to overcome the rejection or objection. Amendments to the application may not introduce new matter. 37 C.F.R. § 1.118.

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Unless the Office explicitly requests the return of a paper, all papers mailed to the applicant are intended to be kept by the applicant for his own records. **The response must be signed by ALL applicants.** 37 C.F.R. § 1.33.

*A. Arguments*

Should the applicant disagree with the examiner's position, the applicant should distinctly and specifically point out the supposed errors in the examiner's action with arguments under the heading "Remarks" in the response. 37 C.F.R. § 1.111. In addition, the applicant must discuss the references cited by the examiner that explain how the claims avoid the references or patentably distinguish from them. *Id.*

*B. Amendments to the Specification/Claims*

An amendment to the specification may remove a rejection or objection. Any amendment to the specification must be made by replacement of the entire paragraph/section. Additions to the specification should be underlined. Any deletions from the claims should be enclosed in brackets (brackets "[" and "]", not parentheses "(" and ")"). Applicants must provide (a) a clean version of an amended paragraph or section or claim and (b) a marked-up version of the same paragraph or section or claim showing changes. Clear instructions must be provided for the location of the amendment entry (e.g., paragraph number, page/line number). Deletion/Addition of an entire paragraph only requires an instruction to delete/add – no marked-up version required for deleted/added items. 37 C.F.R. § 1.121.

It is not necessary to submit a new specification unless one has been required by the Examiner.

### *C. Amendments to the Claims*

An amendment to the claim may remove a rejection or objection. Any amendment to the claim must be made by replacement of the entire claim. Applicants must provide (a) a clean version of an amended paragraph or section or claim and (b) a marked-up version of the same paragraph or section or claim showing changes. Additions to the claim should be underlined. Any deletions from the claims should be enclosed in brackets (brackets "[" and "]", not parentheses "(" and ")"). Deletion/Addition of an entire claim only requires an instruction to delete/add – no marked-up version required for deleted/added items. 37 C.F.R. § 1.121. Parenthetical information is provided after the claim number to indicate how many times the claim has been amended (*e.g.*, "(Once Amended)", "(Twice Amended)", *etc* ...). 37 C.F.R. § 1.119.

For example, if a claim to a chair was originally written:

1. A chair comprising a horizontal seat, a vertical back, and a plurality of vertical support members.

An amended version of this claim might then be written as follows:

1. (Once Amended) A chair comprising a horizontal seat, a vertical back, and [a plurality of] four vertical [support members] legs attached to said seat.

In this example, the words "a plurality of" and "support members" have been deleted from the claim. The words --four-- and --legs attached to said seat-- have been inserted.

### *D. Drawing Corrections*

Finally, correction of the drawings may remove a rejection or objection. Changes to the drawings are submitted as proposed drawing corrections and can be made only with permission of the Office. 37 C.F.R. § 1.123. Proposed drawing corrections should be filed with the

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response, but should be a separate paper. M.P.E.P. § 608.02(r). The proposed corrections should appear in red ink in the drawings. M.P.E.P. § 608.02(v).

## **II. New Matter**

As previously mentioned, no amendment to the specification, claims, or drawings may introduce new matter. 37 C.F.R. § 1.118. "New matter" constitutes any material which meets the following criteria:

- (1) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and
- (2) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

*See* M.P.E.P. § 706.03(o). For example, in the amendment to the claim discussed above, the new limitation of "four legs" would not constitute new matter if the specification or drawings originally described the inclusion of four legs on the chair.

## **III. Period For Response**

An Office action generally sets a time period in which the applicant has to respond to every rejection and objection (called a shortened statutory period). 37 C.F.R. § 1.134. This time period for response appears on the cover letter (form PTO-326) of the Office action. Usually, a 3 month shortened statutory period is set. M.P.E.P. § 710.02(b). The applicant's response must be received within the time period listed on the cover letter, or the application will be held abandoned. 37 C.F.R. § 1.135.

Currently, the Office allows the time period for response to be extended past the shortened statutory period up to a maximum of 6 months (called the maximum 6 month statutory

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period). In order to extend the period of response past the shortened statutory period, a request for an extension of time and payment of the appropriate fee is required. 37 C.F.R. § 1.136. The request must state that it is for "an extension of the period for response under 37 C.F.R. § 1.136(a)." The following table lists the required fees for extensions of the shortened statutory period:

Months Past Response Date	Fee Due (Small / Large Entity)
Response within Time Allowed	None / None
1 Month	\$ 55 / \$ 110
2 Month	\$ 195 / \$ 390
3 Month	\$ 445 / \$ 890
4 Month	\$ 695 / \$ 1,390
5 Month	\$ 945 / \$ 1,890

It is important to note that no extension of time is permitted that extends the period for response past the maximum 6 month statutory period. Responses received after the maximum 6 month statutory period will be held abandoned. 37 C.F.R. § 1.135.

Three examples are provided:

Example 1:

A complete response is filed four months and one day after the mailing date of an Office action. The Office action sets a **3 month** shortened statutory period for response. The response must be accompanied by a fee in the amount of \$190 (for a small entity; \$380 for a large entity) for a 2 month extension of time. The response must also contain a statement requesting "an extension of the period for response under 37 C.F.R. § 1.136(a)."

Example 2:

A complete response is filed five months and one day after the mailing date of an Office action. The Office action sets a **2 month** shortened statutory period for response. The response must be accompanied by a fee in the amount of \$680 (for a small entity; \$1,360 for a large entity) for a 4 month extension of time. The response must also contain a statement requesting "an extension of the period for response under 37 C.F.R. § 1.136(a)."

Example 3:

A complete response is filed six months and one day after the mailing date of an Office action. The Office action sets a **3 month** shortened statutory period for response. The response is held abandoned even if accompanied by a fee and a request for an extension of time. Remember, extensions of time may not be used to extend the period for response past the maximum 6 month statutory period. 37 C.F.R. § 1.135.

**IV. Certificate of Mailing**

To ensure that the Applicant's response is considered timely filed, it is advisable to include a "Certificate of Mailing" on at least one page of the response. *See* 37 C.F.R. § 1.8.

This "Certificate" should consist of the following statement:  
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: "Commissioner of Patents and Trademarks, Washington, D.C. 20231" on (Date of Deposit).

(Name of applicant, assignee, or Registered Representative)

(Signature)

(Date)

This "Certificate" may appear anywhere on the page, and may be handwritten or typed. *Id.* It MUST be signed by the person who actually deposits the paper with the Postal Service, and the date MUST be the actual date on which it is mailed. *Id.*

For the purpose of calculating extensions of time, the date shown on the certificate will be used as the date on which the paper was received by the Office, regardless of the date the



Postal Service actually delivers the response. In this way, postal delays would not affect the extension-of-time fee.

Furthermore, Applicant is encourage to include with the response a self addressed and stamped postcard completely itemizing the papers submitted with applicant's response. *See* M.P.E.P. § 503. When the response is received by the Office, the postcard is date-stamped and returned to the applicant. *Id.* This is an applicant's best indication of the date the Office received the response and if all of the papers submitted have been received.

### **CONCLUSION AND CAVEAT**

The above discussion is not intended to be an exhaustive list of all the topics that may be relevant to this particular Application. The information was provided to familiarize Applicant with the portions of a response that have historically caused problems for *pro se* inventors.

Furthermore, even if Applicant's response is in accordance with the information provided above, there is no guarantee that every requirement of the patent laws (35 U.S.C. §§ 1-376), patent rules (37 C.F.R. §§ 1.1-150.6), and Patent Office policy (M.P.E.P. §§ 101-2591) has been met. The adequacy of a response is determined on a case-by-case basis. *See* 37 C.F.R. § 1.111; M.P.E.P. § 714.02.

### **DETAILED ACTION**

#### ***Oath/Declaration***

1. A new oath or declaration is required because the declaration "I believe I am the original and first inventor of the subject matter which is claimed and for which a patent is sought on the

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invention entitled” sets forth a single inventor, but two inventors signed the declaration. The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

The new declaration should include the statement “I believe I am the original and first inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled”.

### ***Specification***

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant’s use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase “Not Applicable” should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), “Sequence Listings” (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or

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REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a).

"Microfiche Appendices" were accepted by the Office until March 1, 2001.)

(e) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(f) BRIEF SUMMARY OF THE INVENTION.

(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(h) DETAILED DESCRIPTION OF THE INVENTION.

(i) CLAIM OR CLAIMS (commencing on a separate sheet).

(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

2. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

3. The abstract of the disclosure is objected to because

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the use of the word “easy”, in line 7, attempts to purport merits of the invention which should be avoided; and

the abstract should be the last page of the disclosure.

Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities:

on page 1, line 3, “An inner frame tracks slides within the outer frame’s tracks”

should be --The tracks of the inner frame slide within the tracks of the outer frame--;

lines 6-7, “wires, which are in general shape of a “U”, straddles both sides of the tracks and is inserted” should be --wires, which are in general shape of a “U”, straddle both sides of the tracks and are inserted--;

line 11, “rest on glides themselves” should be --rest on glides--;

on page 2 (Abstract), line 2, “the insides of a cabinet” should be --the inside of a cabinet--;

lines 4-5, “The tracks, supported by legs, are themselves mounted on glides” should be --The tracks are supported by legs, which are mounted on glides--;

line 7, “for easy viewing” should be --for viewing--;

on page 5, line 3, “both sides of a frame 2,4,7,8” should be --both sides of a frame 2,4,8-- because reference number “7” is defined as a hole in line 6;

on page 6, line 9, “a pair of legs 40” should be --a pair of legs 41--;

on page 8, lines 1-2, "plurality of linear equally close spaced perforations" should be --plurality of linear, equally close, spaced perforations--; and line 10, "can be slide and/or moved" should be --can slide and/or move--.

Appropriate correction is required.

### *Drawings*

5. Color photographs and color drawings are acceptable only for examination purposes unless a petition filed under 37 CFR 1.84(a)(2) is granted permitting their use as acceptable drawings. In the event that applicant wishes to use the drawings currently on file as acceptable drawings, a petition must be filed for acceptance of the color photographs or color drawings as acceptable drawings. Any such petition must be accompanied by the appropriate fee set forth in 37 CFR 1.17(h), three sets of color drawings or color photographs, as appropriate, and an amendment to the first paragraph of the brief description of the drawings section of the specification which states:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the U.S. Patent and Trademark Office upon request and payment of the necessary fee.

Color photographs will be accepted if the conditions for accepting color drawings have been satisfied.

6. The drawings are objected to because

there only one lead line should extend from a reference number (Figure 1, reference number "4"); and

each figure should be labeled as --Figure 1--, --Figure 2--, and --Figure 3--.

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7. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

*Claim Rejections - 35 USC § 112*

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claims 2 and 3 are indefinite because each dependent claim should have a preamble that identifies the claim from which it depends. In claim 2, the preamble should read --The structure of claim 1 wherein the rails have-- and in claim 3, it should read --The structure of claim 1 wherein the three sets of legs--.

11. Claim 1 is indefinite because it is unclear what constitutes a "box-like frame." How like a box does a frame have to be for it to be considered to be "box-like"? It appears that --box-type frame-- would be a better description of the feature.

12. Claim 1 is further indefinite because it is unclear what constitutes a "like set" of rails. Applicant should clearly set forth each element of the invention and its relationship to other elements to avoid any misunderstanding of what is being claimed.

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13. Claim 1 is indefinite because it is unclear what the "other end" is resting on, i.e., line 9 sets forth, "control member connected to the other end by which that end may rest on but is". It appears from the specification that "control member connected to the other end by which that end may rest on but is" should be --control member connected to the other end, by which that end may rest on said control member, but is--. If this is what applicant intended, please amend the claim accordingly. If this is not what applicant intended to recite, please clarify what the "other end" is resting upon.

***Allowable Subject Matter***

14. Claim 1 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

15. Claims 2 and 3 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

16. The following is a statement of reasons for the indication of allowable subject matter: These claims have been found to be allowable over the prior art of record because the prior art of record neither teaches nor suggests an extendable structure comprising a pair of box-type frames, one located within the other, wherein each frame has four rails that are parallel to each other with the rails of the inner frame being located parallel to the rails of the outer frame and in direct vertical alignment therewith; wherein the outer frame has a leg located at each corner thereof and the inner frame has a pair of legs at one end of the rails thereof, wherein said pair of legs are

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outside of the outer frame to enable said inner frame to be adjusted to change the length of said structure.

*Conclusion*

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. De Dietrich & CIE (FR 2,266,110), McNamara et al. (5,421,646), and West (D455,585 S) are cited to further illustrate the current state of the art of expandable platter/tray structures.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica B Harris whose telephone number is 703-306-9071. The examiner can normally be reached on 9-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P Stodola can be reached on 703-308-2686. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3597 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

*Erica B Harris*

Erica B. Harris  
January 12, 2003

*Daniel P Stodola*

DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600